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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/802,481	03/09/2001	Paul Willard	NEXTP007	5875
21912	7590	03/20/2006		
VAN PELT, YI & JAMES LLP 10050 N. FOOTHILL BLVD #200 CUPERTINO, CA 95014			EXAMINER SUBRAMANIAN, NARAYANSWAMY	
			ART UNIT	PAPER NUMBER
			3624	
DATE MAILED: 03/20/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/802,481

Applicant(s)

WILLARD ET AL.

Examiner

Narayanswamy Subramanian

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 March 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>7/5/01, 11/14/02, 3/19/03</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Original claims 1-14 are pending in the application and have been examined. The objections and rejections are stated below.

Drawings

2. The drawings are objected to by the examiner. This application has been filed with informal drawings, which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

4. Claims 1-10, 13 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitations “obtaining”, “determining”, “selecting” and “transmitting”. It is not clear as to who is doing these acts of obtaining, determining, selecting and transmitting. Similarly claim 10 recites the limitations of “obtaining”, “fixing”, “determining”, “selecting” and “transmitting”. It is not clear as to who is doing these acts. Also in claims 10, 13 and 14, it is also not clear what the phrase “fixing the requested term” entails. The metes and bounds of these limitations are unclear. Claims 2-9 are rejected because they depend on claim 1. Appropriate clarification/correction are required.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cunningham (US Patent 6,014,645) in view of Walker et al (US Patent 6,374,230 B1).

Claim 1, Cunningham teaches a method of transmitting a customized offer to an applicant comprising: determining a set of offers for the applicant (See Cunningham Abstract, Column 4 lines 17-52); selecting an offer from among the set of offers to display to the applicant using information provided by the applicant (See Cunningham Abstract, Column 4 lines 17-52); and transmitting the selected offer to the applicant (See Cunningham Abstract, Column 4 lines 17-52).

Cunningham does not explicitly teach the step of obtaining a requested term from the applicant.

Walker teaches the step of obtaining a requested term from the applicant (See Walker Column 5 lines 39-51).

Both Cunningham and Walker are concerned with providing applicants with financial cards appropriate for them. It would have been obvious to one of ordinary skill in the art at the time of invention to modify Cunningham to include the teachings of Walker. The combination of disclosure suggests that the applicants would have benefited

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by getting the financial cards that meet their needs and preferences (See Walker Column 2 lines 62-66).

Claim 10, Cunningham teaches a method of transmitting a customized offer to an applicant comprising: determining a set of offers for the applicant (See Cunningham Abstract, Column 4 lines 17-52); selecting an offer from among the set of offers to display to the applicant using information provided by the applicant (See Cunningham Abstract, Column 4 lines 17-52); and transmitting the selected offer to the applicant (See Cunningham Abstract, Column 4 lines 17-52).

Cunningham does not explicitly teach the steps of obtaining a requested term from the applicant and fixing the requested term.

Walker teaches the steps of obtaining a requested term from the applicant (See Walker Column 5 lines 39-51) and fixing the requested term (See Walker Column 6 lines 46-53, calculating a price based on parameters received implies this step).

Both Cunningham and Walker are concerned with providing applicants with financial cards appropriate for them. It would have been obvious to one of ordinary skill in the art at the time of invention to modify Cunningham to include the teachings of Walker. The combination of disclosure suggests that the applicants would have benefited by getting the financial cards that meet their needs and preferences (See Walker Column 2 lines 62-66).

Claim 11, Cunningham teaches a system for transmitting a customized offer to an applicant comprising: an interface configured to: obtain information from the applicant (See Cunningham Abstract, Column 4 lines 17-52 and claim 37); and transmit a selected offer to the applicant (See Cunningham Abstract, Column 4 lines 17-52 and claim 37);

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and a processor configured to: determine a set of offers for the applicant (See Cunningham Abstract, Column 4 lines 17-52 and claim 37); and select the selected offer from among the set of offers to display to the applicant using the requested term (See Cunningham Abstract, Column 4 lines 17-52 and claim 37).

Cunningham does not explicitly teach the step of obtaining a requested term from the applicant.

Walker teaches the step of obtaining a requested term from the applicant via a suitable terminal (See Walker Column 5 lines 39-51).

Both Cunningham and Walker are concerned with providing applicants with financial cards appropriate for them. It would have been obvious to one of ordinary skill in the art at the time of invention to modify Cunningham to include the teachings of Walker. The combination of disclosure suggests that the applicants would have benefited by getting the financial cards that meet their needs and preferences (See Walker Column 2 lines 62-66).

Claim 13, Cunningham teaches a system for transmitting a customized offer to an applicant comprising: an interface configured to: obtain information from the applicant(See Cunningham Abstract, Column 4 lines 17-52 and claim 37); and transmit a selected offer to the applicant (See Cunningham Abstract, Column 4 lines 17-52 and claim 37); and a processor configured to: determine a set of offers for the applicant (See Cunningham Abstract, Column 4 lines 17-52 and claim 37); and select the selected offer from among the set of offers to display to the applicant using the requested term (See Cunningham Abstract, Column 4 lines 17-52 and claim 37).

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Cunningham does not explicitly teach the step of obtaining a requested term from the applicant and a processor configured to fix a requested term.

Walker teaches the step of obtaining a requested term from the applicant via a suitable terminal (See Walker Column 5 lines 39-51) and a processor configured to fix a requested term (See Walker Abstract, Column 6 lines 46-53, calculating a price based on parameters received implies this step)

Both Cunningham and Walker are concerned with providing applicants with financial cards appropriate for them. It would have been obvious to one of ordinary skill in the art at the time of invention to modify Cunningham to include the teachings of Walker. The combination of disclosure suggests that the applicants would have benefited by getting the financial cards that meet their needs and preferences (See Walker Column 2 lines 62-66).

Claim 12, Cunningham teaches a computer program product for transmitting a customized offer to an applicant, the computer program product being embodied in a computer readable medium and comprising computer instructions for: obtaining information from an applicant (See Cunningham Abstract, Column 4 lines 17-52 and claim 37); determining a set of offers for the applicant (See Cunningham Abstract, Column 4 lines 17-52 and claim 37); selecting an offer from among the set of offers to display to the applicant using the requested term (See Cunningham Abstract, Column 4 lines 17-52 and claim 37); and transmitting the selected offer to the applicant (See Cunningham Abstract, Column 4 lines 17-52 and claim 37). A computer program product being embodied in a computer readable medium and comprising computer instructions for performing the above steps are inherent in the disclosure of Cunningham.

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Cunningham does not explicitly teach the step of obtaining a requested term from the applicant.

Walker teaches the step of obtaining a requested term from the applicant (See Walker Column 5 lines 39-51).

Both Cunningham and Walker are concerned with providing applicants with financial cards appropriate for them. It would have been obvious to one of ordinary skill in the art at the time of invention to modify Cunningham to include the teachings of Walker. The combination of disclosure suggests that the applicants would have benefited by getting the financial cards that meet their needs and preferences (See Walker Column 2 lines 62-66).

Claim 14, Cunningham teaches a computer program product for transmitting a customized offer to an applicant, the computer program product being embodied in a computer readable medium and comprising computer instructions for: obtaining information from an applicant (See Cunningham Abstract, Column 4 lines 17-52 and claim 37); determining a set of offers for the applicant (See Cunningham Abstract, Column 4 lines 17-52 and claim 37); selecting an offer from among the set of offers to display to the applicant using the requested term (See Cunningham Abstract, Column 4 lines 17-52 and claim 37); and transmitting the selected offer to the applicant (See Cunningham Abstract, Column 4 lines 17-52 and claim 37). A computer program product being embodied in a computer readable medium and comprising computer instructions for performing the above steps are inherent in the disclosure of Cunningham.

Cunningham does not explicitly teach the step of obtaining a requested term from the applicant and a processor configured to fix a requested term.

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Walker teaches the step of obtaining a requested term from the applicant via a suitable terminal (See Walker Column 5 lines 39-51) and a processor configured to fix a requested term (See Walker Abstract, Column 6 lines 46-53, calculating a price based on parameters received implies this step)

Both Cunningham and Walker are concerned with providing applicants with financial cards appropriate for them. It would have been obvious to one of ordinary skill in the art at the time of invention to modify Cunningham to include the teachings of Walker. The combination of disclosure suggests that the applicants would have benefited by getting the financial cards that meet their needs and preferences (See Walker Column 2 lines 62-66).

Claim 2, Cunningham teaches the step wherein a plurality of selected offers are selected and transmitted to the applicant (See Cunningham Column 6 lines 13-23).

Claim 3, Walker teaches the step wherein a plurality of terms are received from the applicant (See Walker Column 5 line 58 – Column 6 line 5).

Claim 7, Walker teaches the step wherein obtaining a requested term from the applicant includes obtaining terms for a current card from the applicant and obtaining desired changes to those terms (See Walker Column 6 lines 19-67).

Claim 8, Walker teaches the step wherein obtaining a requested term from the applicant includes displaying a plurality of cards having different terms to the applicant and determining which of the cards is requested (See Walker Column 1 lines 32-44).

Claims 4-6 and 9, Cunningham does not explicitly teach the steps wherein a plurality of terms are received from the applicant and wherein one of the terms is identified by the applicant as the most important term including preferred values for the

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most important term; wherein the terms are ranked by the applicant and selecting offers that have preferred values for the requested term.

Official notice is taken that ranking the user preferences for products/services that they wish to purchase and selecting offers according user preferences and ranking (of preferences provided by them) is old and well known in the art. For instance before buying a car a user may indicate preferences for a car that has fuel economy, minimum size and one of a set of colors ranked in that order (Fuel economy ranked highest and color lowest) and he/she may further specify fuel economy such that the car must have a minimum rating of 30 mpg on highways. Matching cars that meet such specification and preferences and displaying these matches to the user is old and well known. This helps the users select the car that closely meet their needs and preferences.

It would have been obvious to one of ordinary skill in the art at the time of invention to modify Cunningham to include these steps. The combination of disclosure suggests that the applicants would have benefited by getting offers that closely meet their needs and preferences.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

(a) Walker et al (US Patent 5,970,478) (October 19, 1999) Method, Apparatus and Program for Customizing Credit Accounts

(b) Walker et al (US Patent 6,088,686) (July 11, 2000) System and Method to Performing On-Line Credit Reviews and Approvals


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(c) DeFrancesco et al (US Patent 5,878,403) (March 2, 1999) Computer Implemented Automated Credit Application Analysis and Decision Routing System

(d) Case et al (US Patent 6,510,418 B1) (January 21, 2003) Method and Apparatus for detecting and Deterring the Submission of Similar Offers in a Commerce System

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Narayanswamy Subramanian whose telephone number is (571) 272-6751. The examiner can normally be reached Monday-Thursday from 8:30 AM to 7:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached at (571) 272-6747. The fax number for Formal or Official faxes and Draft to the Patent Office is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PMR or Public PAIR. Status information for unpublished applications is available through Private PMR only. For more information about the PMR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Dr. N. Subramanian
March 15, 2006